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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/698,148	10/31/2003	Jonathan Kagan	VALTX.001A	2819

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EXAMINER
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GRAY, PHILLIP A

ART UNIT	PAPER NUMBER
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3767

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/698,148	<b>Applicant(s)</b> KAGAN ET AL.	
	<b>Examiner</b> Phillip Gray	<b>Art Unit</b> 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 43-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 43-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/30/04, 9/17/04</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS- 12/3/04, 3/10/06</u> .            |

### **DETAILED ACTION**

This office action is in response to applicant's communication of 12/3/04.

Currently Claims 43-61 are pending and rejected below. Applicant previously cancelled claims 1-42.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 43-45, 47-49, 51, 54, 56-59, 61 rejected under 35 U.S.C. 102(e) as being anticipated by Bessler (U.S. Application Number 2004/0039452 A1). Bessler discloses

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an endoscopic gastric bypass device and methods (figures 1-4). Bessler discloses a method for treating obesity with the steps of providing a gastric sleeve (figure 4) with a proximal end (42), distal end (44), and lumen extending therethrough (40), transesophageally advancing the sleeve adjacent an attachment site near the gastroesophageal junction (near 60), advancing the proximal end through the stomach and into the intestines or beyond, and attaching the proximal end at the attachment site to deliver food from the esophagus directly into the intestine (see paragraphs [0012]-[0027]). Bessler discloses a support tissue anchor tubular cuff, at the site of attachment, (42), and extending the sleeve (40) distally of duodenum or beyond (paragraph [0020]. Further Bessler discloses that the length of the tube sleeve could be up to 250cm or beyond in length [0020] and permanently attached to the cuff. The Bessler device is fully capable of being sufficiently flexible that the material traveling through the sleeve is influenced by the natural operation of the pylorus.

Claims 43-51, 54, 56-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Gannoe et al. (U.S. Application Number 2004/0082963 A1). Gannoe discloses a method and device for use in endoscopic organ procedures. Gannoe discloses a method for treating obesity and providing a lengthy sleeve and support tissue anchor with a temp or permanent cuff by suture transesophageally to an attachment site near the gastroesophageal junction, with a proximal and distal ends, where the distal end can extend into the intestines or beyond (See paragraph [0035]). The attachment site support may be implanted with or without the sleeve (see figure 5A-5E, specifically 5E). The Gannoe device is fully capable of being sufficiently flexible that

the material traveling through the sleeve is influenced by the natural operation of the pylorus.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 52-53, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessler or Gannoe. Both references disclose the method claimed except for the specifics of the tissue anchor. Both Bessler and Gannoe discloses the claimed invention except for transmurally implanting a "T-tag" to attach the cuff. It would have been obvious to one having ordinary skill in the art at the time the invention was made

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to transmurally implanting a "T-tag" to attach a cuff, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). The use of the "T-tag" is simply a preferred type of fastener, Gannoe specifically teaches using staples or sutures to attach to a site. It would have been obvious to use a "T-tag" as a preferred type of fastener to securely attach the cuff to the site.

### ***Claim Objections***

Claims 52-53, and 55 are objected to because of the following informalities: the claim limitation of a "T tag" is overly broad, indefinite, unclear, and fails to particularly point out what applicant considers his invention or any corresponding structure what is the tissue anchor. Appropriate correction is required.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gray whose telephone number is (571) 272-7180. The examiner can normally be reached on Monday through Friday, 8:30 a.m. to 4:30 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571) 272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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KEVIN C. SIRMONS  
SUPERVISORY PATENT EXAMINER  
*Kevin C. Sirmons*